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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/761,508      | 01/20/2004  | Todomu Nishino       | 09483/0200797-US0   | 4227             |

7278 7590 12/14/2004

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| EXAMINER |
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RAYFORD, SANDRA M

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| ART UNIT | PAPER NUMBER |
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1772

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/761,508             | NISHINO ET AL.      |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Sandra M. Nolan        | 1772                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 22-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☒ Claim(s) 2-21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4-14-04</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claims***

1. Claims 1-26 are pending.

### ***Election/Restrictions***

2. Claims 22-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 03 December 2004, in response to the 10 November 2004 requirement.

### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on 14 April 2004 was considered by the examiner.

### ***Claim Objections***

4. Claim 3 is objected to because of the following informalities: the word "elastomer" is misspelled. Appropriate correction is required.
5. Claims 2-21 are objected to because of the following informalities: the spacing between words in the first line of each is missing. Appropriate correction is required.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Art Unit: 1772

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1, 3-6, 8-11 and 13-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 and 15 of copending Application No. 10/934393. Although the conflicting claims are not identical, they are not patentably distinct from each other because the crystalline polyesters of the '393 application can be employed with the elastomeric polyesters of this case to make multilayer tubes.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 2, 7 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

What does "comprises a single layer" (recited in line 2 of claim 2) mean?

Please clarify the claims.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ozawa et al (US 5,380,571).

Ozawa teaches tubes (abstract) having inner and outer layers of polyester elastomers (col. 4, lines 28-50).

It fails to teach the properties recited in claim 1.

In the absence of convincing objective evidence to the contrary, it would have been an obvious matter of engineering choice to employ polyesters having suitable physical properties in the Ozawa tubes in order to tailor the tube's properties to the use for which they are intended.

13. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kertesz (US 6,294,234).

Art Unit: 1772

Kertesz teaches fuel conduits (abstract) having thermoplastic crystalline polyester layers (col. 3, lines 1-3) and thermoplastic elastomeric polyester layers (col. 2, lines 63-67). The crystalline/elastomeric layers may alternate (col. 1, lines 63-67; patent claim 2). To avoid charge build-up, one of the layers can be conductive (col. 2, lines 31-33). The polyesters can be blended in a single layer (col. 3, lines 34-36). The conduits can be used in the engine compartments of motor vehicles (col. 3, lines 54-55).

Tubes are deemed to be conduits.

It fails to teach the properties recited in claim 1.

In the absence of convincing objective evidence to the contrary, it would have been an obvious matter of engineering choice to employ polyesters having suitable physical properties in the Kertesz conduits in order to tailor the tube's properties to the use for which they are intended.

Use of the conduits of Kertesz as feed tubes and/or in combination with other conventional components of systems for transferring fuels, per applicants' claims 6-15, is deemed a matter of intended use and does not render these claims patentable over the Kertesz conduits.

14. Claims 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kertesz as applied to claims 1-15 above, and further in view of Ostrander et al (US-5,960,977).

The examiner understands the surface resistivities of claims 16-21 to mean that the layers are conductive.

Art Unit: 1772

Kertesz is discussed above. It fails to teach that its inner layers have the resistivities claimed.

Ostrander teaches tubing to connect a vehicle fuel tank to a fuel source (col. 1, lines 11-14). The tubing has an inner layer with a resistivity of  $10^4$  to  $10^9$  ohms/cm<sup>2</sup> (col. 6, lines 15-32), which layer dissipates electric charge to prevent deterioration (col. 1, lines 59-67).

The patents are analogous because they both deal with fuel conduits having antistatic layers in them.

It would have been obvious to one having ordinary skill in the art at the time of the invention to employ the conductive inner layers of Ostrander in the conduits of Kertesz in order to prevent static deterioration in the conduits.

The motivation to employ the conductive inner layers of Ostrander in the conduits of Kertesz is found at col. 1, lines 59-67 of Ostrander, where deterioration due to static charges is taught; and at col. 2, lines 31-33 of Kertesz, where the use of conductive layers is taught.

It is deemed desirable to make fuel conduits that are stable so that their useful lives can be maximized.

### ***Conclusion***

Any inquiry concerning this communication should be addressed to Sandra M. Nolan-Rayford, at telephone number 571/272-1495. She can normally be reached Monday through Thursday, from 6:30 am to 4:00 pm, Eastern Time.

Art Unit: 1772

If attempts to reach the examiner are unsuccessful, her supervisor, Harold Pyon, can be reached at 571/272-1498.

The fax number for patent application documents is 703/872-9306.

*S. M. Nolan-Rayford*  
S. M. Nolan-Rayford  
Primary Examiner  
Technology Center 1700

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